

## **REMARKS/ARGUMENTS**

### **1. Summary of the Office Action**

Claims 1-3, 5, 6, 9-15 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,778,499 (hereinafter Senarath).

Claims 4, 8, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Senarath in view of U.S. Patent No. 6,403,947 (hereinafter Hoyt).

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Senarath in view of U.S. Patent No. 6,671,258 (hereinafter Bonneau).

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Senarath in view of Hoyt as applied to claims 17 and 18 above, and further in view of Bonneau.

### **2. Response to 35 U.S.C. § 102 Rejections**

In response to the above Office Action, the Applicants have amended the claims and respectfully request reconsideration thereof. All the amendments are supported by the specification as originally filed, and accordingly, no new matter has been added.

To anticipate a claim, the reference must teach every element of the claim." *A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.*" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants contend that each and every element of the present claim is simply not found in Senarath. Senarath teaches a method and apparatus for smoothing bit rate transition in a bursty input data stream. In particular, the method of Senarath includes the steps of receiving the input data stream in a buffer, periodically measuring the occupancy level of the buffer and withdrawing the contents of the buffer at an output rate. However, Senarath fails to teach or suggest the

present claims 1, 6 and 11 which have been amended to include the feature of using monotonically decreasing function for performing a period sweep (claim 1) or decreasing the packet output rate (claim 6) or varying the inter-packet transmission times (claims 11 and 21). Indeed, Senarath is not concerned with using monotonically decreasing function in the invention as Senarath determines the buffer occupancy level directly from the buffer. More specifically, the “buffer 36 monitors its occupancy level at regular intervals and periodically provides the buffer occupancy level  $L_{BUF}(t)$  to the controller 38 via control link 40” (Col.5, lines 50-53). Furthermore, the Office Action asserts on page 4, paragraph 4 that Senarath does not teach or suggest such a feature.

As established above, Senarath fails to teach or even suggest each and every element of the present claims. Accordingly, the present claims are patentable over Senarath.

### **3. Response to 35 U.S.C. § 103 Rejections**

Claims 4, 8, 17 and 18 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over Senarath in view of Hoyt. To establish a prima facie case of obviousness, however, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on the applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present case, there has been no showing of the required motivation for the suggested combination, nor has there been any showing of a reasonable expectation of success. The Office Action cites Senarath in view of Hoyt and suggests that it would have been obvious to one of ordinary skill in the art to combine the teachings of these references. However, this conclusion finds no support in the references. Indeed, the Office Action cites no motivation for such a combination, other than a general desire to improve the system compatibility (Office Action, page 5, lines 1-2). This rote invocation of a general desire to make existing technologies

better is an insufficient basis for reaching a conclusion of obviousness. Instead, what is needed is an actual showing of motivation to make the desired combination.

In addition, there has been no showing that one would (or even could) expect success in combining the teachings of the references. Senarath is concerned with smoothing bit rate transitions in a bursty input data stream. Hoyt, on the other hand, is concerned with an imaging system for obtaining images with essentially diffraction-limited spatial resolution. In particular, Hoyt applies monotonically decreasing function for polarized light. Nothing in the references nor the Office Action suggests how to apply the monotonically decreasing function in the context of imaging to the invention of Senarath. Consequently, there has been no showing of an expectation of success resulting from the combination of these references.

Rather than making out a proper *prima facie* case of obviousness then, it appears the teachings of the present application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by the present applicants. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims. Indeed, the U.S. Court of Appeals for the Federal Circuit has rejected such applications of hindsight by specifically indicating that when an obviousness rejection is made based upon a combination of references, an examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added). Merely indicating, as in the present Office Action, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is inadequate.

As demonstrated above, the present Office Action deconstructs the subject matter of the claims into its constituent components, states where each such component may be found in one of the cited references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support the present rejections. The burden is on the Examiner to show *why* one would be so motivated as to come up with the combination. *Rouffet* at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever,

experience a patentable technical advance. Instead, in complex scientific fields the [Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.") Accordingly, the present rejections should be removed.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over Senarath in view of Hoyt as applied to claims 17 and 18 above, and further in view of Bonneau. As established above, the combination of Senarath and Hoyt is flawed. Therefore, the present claims are patentable over the cited references.

Even if Bonneau is considered with the references, the combination of the references is flawed. Similarly, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In this case, each of the references themselves provides what appears to be a complete solution for managing data traffic. Neither of the references suggests that additional steps are needed to improve the data traffic streaming beyond the techniques disclosed therein. For example, Senarath is concerned with smoothing bit rate transition in a bursty input data stream by periodically measuring the occupancy level of the buffer and withdrawing the contents of the buffer at an output rate (Senarath, Abstract). On the other hand, Bonneau uses a buffering system with "an n-level hierarchy of memory partitions, wherein each non-top level partition has one or more child partitions at an immediately lower level of the hierarchy. The memory partitions at the top-most level are pre-configured with a target memory occupancy size, and the target occupancy for each memory partition situated at a lower level is recursively computed in a dynamic manner based on the aggregate congestion of its parent partition, until the target occupancies for the bottom-most memory partitions are determined" (Bonneau, Abstract). Nothing in these disclosures would suggest that any combination of these processes is desirable. Consequently, there exists no motivation for the recited combination.


4. **Conclusion**

Having tendered the above remarks and amended the claims as indicated herein, the Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Jaina Chua at (408) 947-8200.

Respectfully submitted,

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